REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 1, 8, and 15 have been amended as shown above.

Claims 1-20 remain pending in this application.

Reconsideration and full allowance of Claims 1-20 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1, 2, 15, and 16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,625,325 to Rotzoll et al. ("*Rotzoll*"). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Rotzoll recites a system and method for phase lock loop ("PLL") gain stabilization. (*Abstract*). The system allows the gain variation of a voltage controlled oscillator ("VCO") to be controlled. (*Abstract*). The VCO includes an LC circuit (element 74) that has various switches (elements 711-713) and capacitors (elements 701-703). (*Figure 7; Col. 4, Lines 33-34*). A

digital control signal (element 731) is used to control the gain of a phase detector and the gain of the VCO by controlling the switches. (*Col. 4, Lines 45-56*). The digital control signal represents a selected frequency band for the VCO. (*Col. 4, Lines 43-44*).

Rotzoll simply recites that capacitors in an LC circuit of a VCO are adjusted to alter the gain of the VCO. *Rotzoll* also recites that the capacitors are adjusted based on a digital control signal. *Rotzoll* lacks any mention that the digital control signal is based on a difference between a "resonant frequency" of the LC circuit and a "reference frequency." Instead, *Rotzoll* clearly recites that the digital control signal is based on the desired frequency band of the VCO. In addition, *Rotzoll* fails to mention that the capacitors are adjusted to make a "resonant frequency" of the LC circuit more like a "reference frequency."

Because of this, *Rotzoll* fails to anticipate controlling the switching of one or more integrated circuit capacitors "in response to [a] difference between" a "resonant frequency" of an "inductive-capacitive resonant circuit" and a "reference frequency" so as to "alter the resonant frequency towards the reference frequency" as recited in Claim 1. *Rotzoll* also fails to anticipate "selectively switching one or more integrated circuit capacitors" in response to a "difference" between a "resonant frequency" of an "inductive-capacitive resonant circuit" and a "reference frequency" so as to "alter the resonant frequency towards the reference frequency" as recited in Claim 15.

For these reasons, the Office Action has not established that *Rotzoll* anticipates all elements of Claims 1 and 15 (and their dependent claims). Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1, 2, 15, and

16.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 3-6, 8-13, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over *Rotzoll* in view of U.S. Patent No. 6,738,601 to Rofougaran et al. ("*Rofougaran*"). The Office Action rejects Claims 7 and 14 under 35 U.S.C. § 103(a) as being unpatentable over *Rotzoll* and *Rofougaran* in further view of U.S. Patent No. 6,013,958 to Aytur ("*Aytur*"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP § 2142; In re Fritch, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)*). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)*). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (*MPEP § 2142; In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)*). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); In re Grabiak, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)*).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)*). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP § 2142*).

As described above in Section I, *Rotzoll* fails to disclose, teach, or suggest various elements recited in Claims 1 and 15. *Rotzoll* also fails to disclose, teach, or suggest analogous elements recited in Claim 8. The Office Action does not rely on *Rofougaran* as disclosing, teaching, or suggesting these elements of Claims 1, 8, and 15. As a result, the Office Action has not established that the proposed *Rotzoll-Rofougaran* combination discloses, teaches, or suggests all elements of Claim 8.

Claims 3-7, 9-14, and 17-20 depend from Claims 1, 8, and 15, respectively. The Office Action has not established that the proposed *Rotzoll-Rofougaran* combination discloses, teaches, or suggests all elements of Claims 1, 8, and 15. Because of this, the Office Action also has not established that the proposed *Rotzoll-Rofougaran* combination discloses, teaches, or suggests all elements of Claims 3-7, 9-14, and 17-20.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claims 3-7, 9-14, and 17-20. Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 3-7, 9-14, and 17-20.

III. CONCLUSION

For the foregoing reasons, the Applicant respectfully requests full allowance of all pending claims and that this application be passed to issuance.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number below or at *wmunck@davismunck.com.*

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Oct. 8, 2009

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